

## SUPPORT FOR AMENDMENTS

Support for the amendments to claim 24 can be found, *inter alia*, at page 13, lines 8-10.

Claims 1-24 and 26-31 are currently pending.

## REJECTION UNDER 35 U.S.C. §112

The Office Action rejected claims 24 and 29-31 under 35 U.S.C. §112, second paragraph, as being indefinite for containing the terms “dull” and “dirty.” Although Applicant respectfully disagrees with this rejection and believes that these terms are readily understood by those skilled in the art in the context of the present invention (that is, in the context of skin or other keratin material becoming dull or dirty), solely to facilitate prosecution of this application Applicant has amended claim 24 by replacing these terms with the phrase --an increase in sebum flow from a keratin material--. Applicant respectfully submits that this amendment renders the §112 rejection moot, and that this rejection should be withdrawn.

## REJECTIONS UNDER 35 U.S.C. §§102 and 103

The Office Action rejected claims 1-24 and 26-31 under 35 U.S.C. §102 as anticipated by U.S. patent 6,071,524 (“Ribier I”). The Office Action also rejected claims 1-6, 15, 17-19, 21, 23, 24 and 26-29 under 35 U.S.C. §§103 as obvious over JP 61236737 (“Kuraray”) alone or in combination with U.S. patent 5,834,013 (“Ribier II”), U.S. patent 6,207,694 (“Murad”) or U.S. patent 6,110,450 (“Bergmann”). In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of these rejections.

Ribier I does not disclose or suggest, either expressly or inherently, the claimed methods. Ribier I does not contain any disclosure that would result in a person using a pollution penetration limiting effective amount of phytanetriol on keratin materials in need of the claimed protection, improvement, reduction and/or prevention each and every time Ribier I's compositions were used. For pollution penetration limitation to occur, sufficient pollution must exist in the atmosphere for phytanetriol to be able to effect limitation of such penetration. However, geographic areas exist in which pollution generation is limited such that insufficient pollution exists in the atmosphere to allow phytanetriol to limit penetration in this manner (for example, Mackinac Island in Michigan where no motor vehicles are allowed and little or no industry exists or a Hawaiian Island which contains little or no industry and strong winds/plentiful rain). Thus, not every person using Ribier I's compositions in such locations would limit pollution penetration on keratin materials in need of the claimed protection, improvement, reduction and/or prevention. Accordingly, Ribier I cannot inevitably lead to, or inherently anticipate, the claimed methods.

Moreover, Ribier I does not provide any instruction regarding how to use or apply his compositions. Thus, Ribier I does not contain any teaching regarding application or use that would result each and every time in limiting the adhesion or adsorption of pollutants to skin, thereby limiting penetration of pollutants into the skin. Accordingly, Ribier I does not inherently anticipate the claimed methods.

In other words, Ribier I does not necessarily result in limiting adhesion or adsorption of pollutants to keratin materials in need of the claimed protection, improvement, reduction and/or prevention. Rather, Ribier I merely results in the possibility that the claimed pollution penetration limitation on keratin materials in need of such protection, improvement, reduction and/or prevention may occur. As noted by the court in *In re Oelrich*, 666 F.2d 578, 581, 212

USPQ 323 (CCPA 1981), the mere fact that a certain thing may result from a given set of circumstances is not sufficient to prove inherency. Inherency may not be established by probabilities or possibilities. Something that is inherent must inevitably be the result each and every time. Because Ribier I merely results in the possibility that the claimed methods may occur, it cannot inherently anticipate the claimed invention.

Moreover, as noted by the Board of Patent Appeals and Interferences in *Ex parte Skinner*, 2 USPQ2d 1788, before the Patent Office can switch the burden of proof of showing non-inherency to the Applicant, the Patent Office must provide some evidence or scientific reasoning to establish the reasonableness of the belief that the functional limitation is an inherent characteristic of the prior art. In this case, the Patent Office has provided no such evidence.

In view of the above, Applicant respectfully submits that the rejection under 35 U.S.C. §102 is unsustainable and should be withdrawn.

Moreover, because claims 7-14, 16, 20, 22, 30 and 31 were not rejected under 35 U.S.C. §103, Applicant respectfully submits that these claims are in condition for allowance.

Regarding the §103 rejections, none of the cited references teaches or suggests the claimed methods which require applying a pollutant penetration limiting effective amount of phytanetriol to keratin materials. Kuraray, the primary reference, merely discloses that phytanetriol protects hair and skin, but does not state how such protection occurs. Thus, Kuraray neither teaches nor suggests using a pollutant penetration limiting effective amount of phytanetriol. Rather, Kuraray's protection could come from any source such as, for example, phytanetriol's known moisturizing properties (arguably, moisturizing compositions "protect" hair and skin because they prevent dehydration). None of the secondary references, Ribier II, Bergman or Murad, compensate for Kuraray's deficiencies. None of these

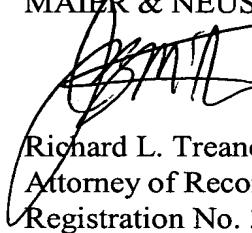
secondary references teach or suggest using a pollutant penetration limiting effective amount of phytanetriol to achieve the claimed protection. Thus, the combination of the cited references cannot yield the presently claimed invention and, thus, cannot render it obvious.

In view of the above, Applicant respectfully submits that the rejections under 35 U.S.C. §103 should be withdrawn.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Richard L. Treanor  
Attorney of Record  
Registration No. 36,379

Jeffrey B. McIntyre  
Registration No. 36,867



**22850**

Tel #: (703) 413-3000  
Fax #: (703) 413-2220

I:\user\jBMC\l'Oreal\208594 Amd (apr03) Conv.doc